

## REMARKS

Claims 1-26 and 28-54 were pending in the application prior to the foregoing amendments, claim 27 having been previously canceled. Claims 1-26 and 28-54 stand rejected. Claims 1, 4-14, 17-26, 28, 42, 51, and 53 have been amended. Claims 2, 3, 15, 16, 29, 43, 52, and 54 have been canceled. Claims 1, 4-14, 17-26, 28, 30-42, 44-51, and 53 remain pending after the entry of the foregoing amendments.

No new matter has been added.

### Support for Amendments

In general, the claims have been amended to recite a “device” rather than an “apparatus,” and the claims have been further amended to recite “a component” rather than “a first component” and “a second component.” These amendments are intended to clarify that multiple functions of generating vibration and transmitting and/or receiving data and/or voice signals are performed in a single device, and not in separate devices or components that could be electrically interconnected to form an apparatus. These amendments are further intended to clarify that the device is operable both for use in a medical diagnosis and as one or more of a cellular phone, pager, beeper, and other portable electronic communication device operative to transmit and/or receive data and/or voice signals. These amendments are not intended to narrow the scope of the claims.

Claim 1 has been amended to recite that the claimed device is multi-functional and has a component for generating vibration, the component being adapted to generate vibration in response to a remote wireless signal when the device is operated as one or more of various portable electronic communication devices operative to transmit and/or receive data and/or voice signals. As such, the features of claims 2 and 3 are subsumed into claim 1. Claim 1 further recites the component being further adapted to generate vibration in for use in a medical diagnosis in response to a signal generated by the device. Support for the amendments can be found in the specification at least in paragraph [0035] and FIG. 1.

Claims 4-13 depend directly or indirectly from claim 1 and have been amended accordingly to ensure proper antecedent basis for the elements recited therein.

Claim 14 has been amended to recite that the claimed device is multi-functional and has a component for generating vibration in first and second modes. Claim 14 has also been

amended to recite a selector for selecting one of the vibration modes. Support for the amendments can be found in the specification at least in paragraph [0035]. Claim 14 has been further amended to recite wherein in one of said first and second modes the device functions as one or more of a cellular phone, pager, beeper, and other portable electronic device operative to transmit and/or receive data and/or voice signals, and wherein in the other of said first and second modes the device operates as a probe for detecting neuropathy in a subject. As such, the features of claims 15 and 16 are subsumed into claim 14.

Claims 17-25 depend directly or indirectly from claim 14 and have been amended accordingly to ensure proper antecedent basis for the elements recited therein. Additionally, a typographical error has been corrected in claim 20.

Claim 26 has been amended to recite that device further functions as one or more of a cellular phone, pager, beeper, and other portable electronic device operative to transmit and/or receive data and/or voice signals. Support for this amendment can be found at least in paragraphs [0033] and [0035].

Claim 28 has been amended to recite that claimed method comprises providing a multi-functional device comprising a component for generating vibration, the component being adapted to generate vibration in response to a remote wireless signal when the device is operated as one or more of a cellular phone, pager, beeper, and other portable electronic communication device operative to transmit and/or receive data and/or voice signal. As such, the features of claim 29 are subsumed into claim 28. Claim 28 has been further amended to recite the component being further adapted to generate vibration for use in a medical diagnosis in response to a signal generated by the device, and the method comprising selecting a mode of vibration to be used in medical diagnosis. Support for the amendments can be found in the specification at least in paragraph [0035].

Claim 42 has been amended to recite that claimed method comprises providing a multi-functional device comprising a component for generating vibration, the component being adapted to generate vibration in response to a remote wireless signal when the device is operated as one or more of a cellular phone, pager, beeper, and other portable electronic communication device operative to transmit and/or receive data and/or voice signals. As such, the features of claim 43 are subsumed into claim 42. Claim 42 has been further amended to recite the component being further adapted to generate vibration for use in a

medical diagnosis in response to a signal generated by the device, and the method comprising selecting a mode of vibration to be used in detecting neuropathy. Support for the amendments can be found in the specification at least in paragraph [0035].

Claim 51 has been amended to recite that claimed method comprises providing a multi-functional device comprising a component for generating vibration, the component being adapted to generate vibration in response to a remote wireless signal when the device is operated as one or more of a cellular phone, pager, beeper, and other portable electronic communication device operative to transmit and/or receive data and/or voice signals. As such, the features of claim 52 are subsumed into claim 51. Claim 51 has been further amended to recite the component being further adapted to generate vibration for use in a medical diagnosis in response to a signal generated by the device, and the method comprising selecting a mode of vibration to be used in medical diagnosis. Support for the amendments can be found in the specification at least in paragraph [0035].

Claim 53 has been amended to recite that claimed method comprises providing a multi-functional device comprising a component for generating vibration, the component being adapted to generate vibration in response to a remote wireless signal when the device is operated as one or more of a cellular phone, pager, beeper, and other portable electronic communication device operative to transmit and/or receive data and/or voice signals. As such, the features of claim 54 are subsumed into claim 53. Claim 53 has been further amended to recite the component being further adapted to generate vibration for use in a medical diagnosis in response to a signal generated by the device, and the method comprising selecting a mode of vibration to be used in detecting neuropathy. Support for the amendments can be found in the specification at least in paragraph [0035].

### **35 USC § 102(b) Rejection (*LaCourse*)**

Claims 1, 5-11, 28, 30, 32, 34, 36-42, 44-47, 49, 51, and 53 stand rejected as allegedly being anticipated under § 102(b) by U.S. Patent No. 5,002,065 (*LaCourse*).

### **Claims 1 and 5-11**

As-amended claim 1 (and thus its dependent claims 5-11) recites a device comprising a component adapted to generate vibration in response to a remote wireless

signal when the device is operated as one or more of a cellular phone, pager, beeper, and other portable electronic communication device operative to transmit and/or receive data and/or voice signals. Applicant respectfully submits that *LaCourse* does not teach, suggest, or disclose such a device.

*LaCourse* discloses a component for generating vibration. However, *LaCourse* does not disclose a portable electronic communication device operative to transmit and/or receive data and/or voice signals, such as a cellular phone, pager, or beeper. *A fortiori*, *LaCourse* does not disclose a component adapted to generate vibration when the device is operated as one or more of such portable electronic communication devices. Specifically, *LaCourse* uses a component, the tool (103), to generate a vibration in response a signal, the vibration being used for medical diagnosis. The tool (103) does not generate vibration in response to another signal and the device cannot operate as a portable electronic communication device operative to transmit and/or receive data and/or voice signals.

It is well settled that a reference must teach every element or aspect of the claim in order to be considered as prior art under § 102(b). MPEP 706.02(IV). Therefore, the device of *LaCourse* does not anticipate the present invention under § 102(b) because it fails to teach every element claimed in the present invention.

Accordingly, Applicant respectfully requests that the anticipation rejections over *LaCourse* be withdrawn with respect to claims 1, 5-11.

**Claims 28, 30, 32, 34, 36-41, 42, 44-47, 51, and 53**

With regard to claims 28, 30, 32, 34, 36-41, 42, 44-47, 49, 51, and 53, Applicant respectfully submits that *LaCourse* does not teach, disclose, or suggest a method comprising providing a multi-functional device comprising a component for generating vibration in response to a remote wireless signal when operated as one or more of various portable electronic communication devices operative to transmit and/or receive data and/or voice signals. Further, *LaCourse* does not disclose a method comprising selecting a mode of vibration to be used in medical diagnosis.

The present invention, as recited in the as-amended claims 28, 30, 32, 34, 36-41, 42, 44-47, 49, 51, and 53, teaches a method that comprises providing a device having a component that can both generate vibration and function as a portable electronic

communication device operative to transmit and/or receive data and/or voice signals, and selecting a mode of vibration for use in medical diagnosis. In contrast, *LaCourse* teaches a method wherein a component generates a vibration used in medical diagnosis, but *LaCourse* fails to teach a method wherein the component is adapted to generate vibration when the device functions as a portable electronic communication device operative to transmit and/or receive data and/or voice signals. *LaCourse* further fails to teach selecting a mode of vibration; such a feature would be unnecessary in *LaCourse* because the device disclosed therein has only one mode of vibration, i.e., that used in medical diagnosis.

It is well settled that a reference must teach every element or aspect of the claim in order to be considered as prior art under § 102(b). Therefore, because *LaCourse* does not teach every element of the claims, *LaCourse* does not anticipate the claimed invention and should not be considered prior art under § 102(b) as to claims 28, 30, 32, 34, 36-41, 42, 44-47, 49, 51, and 53.

Accordingly, Applicant respectfully requests that the anticipation rejection over *LaCourse* be withdrawn with respect to claims 28, 30, 32, 34, 36-41, 42, 44-47, 49, 51, and 53.

### **35 USC § 102(e) Rejection (*Campbell*)**

Claims 1-26 stand rejected as allegedly being anticipated under § 102(e) by U.S. Patent Application No. 2003/0060765 (*Campbell*). Claims 2, 3, 15, and 16 have been canceled.

As-amended independent claims 1, 14, and 26 (and consequently their dependent claims 4-13 and 16-25) recite a device comprising a component for generating vibration, the component being adapted to generate vibration in response to a remote wireless signal when the device is operated as one or more of a cellular phone, pager, beeper, and other portable electronic communication device operative to transmit and/or receive data and/or voice signals, the component being further adapted to generate vibration for use in a medical diagnosis in response to a signal generated by the device. Applicant respectfully submits that *Campbell* does not teach, suggest, or disclose such a device.

*Campbell* discloses a component for generating vibration. However, *Campbell* does not disclose a device that is operable as a portable electronic communication device

operative to transmit and/or receive data and/or voice signals, such as a cellular phone, pager, or beeper. The *Campbell* device does not function as a pager, beeper, cellular phone, or other mobile electronic communication device, and the disclosure makes no mention of any such devices. In fact, the only mention of “phone” in *Campbell* is as a remote input device for use in programming the device that is the subject of the invention [0054]. The office action points to paragraph [0061], which merely makes an unspecific reference to remote programming of the device. Neither of these portions of disclosure support the office action’s assertion that *Campbell* discloses a device functioning as a pager, beeper, cellular phone, or other mobile device.

The office action asserts that because the infusion device of *Campbell* can receive a signal from a remote device and acknowledge that signal, the device is considered to function as a pager or a beeper. The amendments to independent claims 1, 14, and 26 obviate this ground of rejection, because even if the Examiner’s interpretation is correct, *Campbell* is deficient with regard to the as-amended claims for at least two reasons. First, the component that generates vibration in *Campbell* does not do so when the device is operated as one or more of a cellular phone, pager, beeper, and other portable electronic device operative to transmit and/or receive data and/or voice signals. Second, the component in *Campbell* generates vibration only as an alarm or alert to a user, and not for use in a medical diagnosis.

In particular, *Campbell* does not disclose a component adapted to generate vibration for use in a medical diagnosis. The office action asserts that it is immaterial that *Campbell* is not directed to a diagnostic device unless the recitation of that intended use of the claimed invention results in a structural difference between the claimed invention and the prior art so as to patentably distinguish the claimed invention from the prior art. But the claimed invention does have at least a structural difference from the device of *Campbell*. The device of claimed invention includes a component that can generate specific vibrations and/or combinations or sequences of vibrations that are useful in medical diagnosis, whereas the vibrations of the device of *Campbell* are useful only for providing alerts. *Campbell* does not teach, suggest, or disclose any awareness of the possibility that vibration can be used for diagnosis, and therefore cannot be read to disclose a device capable of generating vibrations that are used for medical diagnosis. Therefore, the functional differences between the

claimed invention and the *Campbell* device are manifested in structural differences that render the claimed invention patentably distinguishable. Further, as discussed below with regard to claims 14 and 17-25, the claimed invention comprises a selector cooperating with the component to enable the component to generate vibration for use in a medical diagnosis, whereas the *Campbell* device is enabled to generate vibration only in response to an error or status condition that is not selected by a selector.

With regard to claim 14, *Campbell* does not disclose a selector. As-amended claim 14 (and its dependent claims 17-25) recites a device having a selector cooperating with the component to enable the component to generate vibration for use in a medical diagnosis. Applicant respectfully submits that *Campbell* does not disclose a device having such a selector, because the *Campbell* device does not enable a user to select the vibration that is generated by the component, and further because the component of the *Campbell* device is not adapted to generate vibration in a different mode, e.g., in response to a remote wireless signal when the device is used as a portable electronic communication device operative to transmit and/or receive data and/or voice signals. Indeed, as discussed above, *Campbell* discloses a component, a vibrator (36), for generating vibration when the device is operating in only a single mode. Moreover, the vibration generated by the *Campbell* device is therapeutic, and the sole purpose of the vibrator (36) in *Campbell* is to provide feedback to an individual about the operational state of the device. The vibration of *Campbell* is not provided to perform any sort of medical diagnosis [0056].

It is well settled that a reference must teach every aspect of the claim in order to be considered as prior art under § 102(e). Therefore, for the foregoing reasons, *Campbell* does not anticipate the claimed invention and should not be considered prior art under § 102(e) in regard to claims 1, 4-14, and 17-26.

Accordingly, Applicant respectfully requests that the anticipation rejections over *Campbell* be withdrawn with respect to claims 1, 4-14, and 17-26.

#### **35 USC § 103(a) Rejection (*LaCourse* in view of *Laudadio*)**

Claims 31, 33, 35, 48, and 50 stand rejected as allegedly being anticipated under § 103(a) by U.S. Patent No. 5,002,065 (*LaCourse*) in view of U.S. Patent No. 5,931,793 (*Laudadio*).

Applicant respectfully submits that the office action does not establish a *prima facie* case of obviousness with regard to claims 31, 33, 35, 48, and 50. A *prima facie* case of obviousness requires that all claim limitations be taught or suggested in the prior art. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *In re Royka*, 490 F.2d 981 (CCPA 1974).

Without prejudice to the individual merits of claims 31, 33, 35, 48, and 50, an obviousness rejection under § 103(a) cannot be sustained because, as discussed above, *LaCourse* does not disclose every element of the invention as claimed in independent claims 28 and 42, from which these claims respectively depend. Moreover, *Laudadio* does not remedy this deficiency. Therefore, *LaCourse* in view of *Laudadio* cannot render obvious claims 31, 33, 35, 48, and 50.

Accordingly, Applicant respectfully requests that this rejection be withdrawn with respect to claims 31, 33, 35, 48, and 50.

#### **35 USC § 103(a) Rejection (*LaCourse* in view of *Causey*)**

Claims 2, 29, 43, 52, and 54 stand rejected as allegedly being anticipated under § 103(a) by U.S. Patent No. 5,002,065 (*LaCourse*) in view of U.S. Patent No. 6,641,533 (*Causey*). Claims 2, 29, 43, 52, and 54 have been canceled because their features have been incorporated into claims 1, 28, 42, 51, and 53, respectively.

Applicant respectfully submits that the office action does not establish a *prima facie* case of obviousness with regard to claims 1, 28, 42, 51, and 53. A *prima facie* case of obviousness requires that all claim limitations be taught or suggested in the prior art. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *In re Royka*, 490 F.2d 981 (CCPA 1974). The office action asserts that *Causey* teaches the alternative use of wired or wireless signals, making up for the failure of *LaCourse* to disclose anything other than wired signals.

An obviousness rejection under § 103(a) fails because, as discussed above, *LaCourse* alone, or in combination with *Causey* (disclosing electronic signals that can be equivalently transferred over a wire or wirelessly), does not disclose every element of the as-claimed invention. Therefore, *LaCourse* in view of *Causey* cannot render obvious claims 1, 28, 42, 51, and 53.

Accordingly, Applicant respectfully requests that this rejection be withdrawn with respect to claims 1, 28, 42, 51, and 53.

## CONCLUSION

For all of the foregoing reasons, Applicant respectfully submits that the application is in condition for allowance. Withdrawal of all objection and rejections, and allowance of claims 1, 4-14, 17-26, 28, 30-42, 44-51, and 53 is respectfully requested. An early notice of allowance of those claims is earnestly solicited.

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